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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Koji Fukumoto

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EXAMINER

NASH, LASHANYA RENEE

ART UNIT

PAPER NUMBER

2153

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/781,329	Applicant(s) FUKUMOTO ET AL.	
	Examiner LaShanya R Nash	Art Unit 2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/11/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to an Amendment filed September 30, 2005.

Claims 1-9 are presented for further consideration.

Response to Arguments

Applicant's arguments, see Remarks/ Response to Arguments, filed September 30, 2005 have been fully considered but are moot in view of the new grounds of rejection based on newly found prior art, Gilbert (US Patent 6,529,942).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, and 4-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Gilbert (US Patent 6,529,942), hereinafter referred to as Gilbert.

Gilbert teaches an email system and method which allows the originating user to customize text for a specific recipient in a multiple recipient email system (i.e. broadcast), (abstract).

In reference to claim 1, Gilbert shows that the E-mail system with recipient-specific content system includes:

- A receiving device (i.e. receiver; Figure 1-receiver) receiving transmission information transmitted from a sender (Figure 1-sender) to a plurality of receivers, (column 3, line 24 to column 4, line 30) and
 - An emphasizing device (i.e. network computer of sender) emphasizing and highlighting (i.e. size, color, bold, italic, etc.; column 4, lines 54-67) different parts the transmission information for respective receivers (i.e. select users to receive modified email message; column 5, lines 5-26), and preparing E-mail information (i.e. embedding text format commands) including all of the transmission information with the transmission information in which the different parts are for respective receiver (columns 5-7),
 - A transmitting device transmitting the E-mail information including all of the transmission information to respective receivers (i.e. receiver sensitive formatting; Figure 6- Emails for John, Harry, Mary and Original Email), (column 8, line 44 to column 9, line 18).

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In reference to claim 2, Gilbert shows receiving device that receives a part of the transmission information that the sender designates and information about a corresponding transmission destination and emphasizing device that emphasizes and highlights the designated part and prepares E-mail information for a receiver corresponding to the transmission destination, (columns 5-6).

In reference to claim 4, Gilbert shows a terminal apparatus (Figure 1- sender) comprising:

- Transmitting device transmitting transmission information prepared for a plurality of receivers (i.e. via network connection; column 3, lines 58 to column 4, line 16) and
- An indication device (i.e. software program executing on networked computer of sender; column 4, line 30 to column 5, line 5) indicating E-mail information that emphasizes and highlights different parts of the transmission information for respective receivers; preparing E-mail information for respective receivers including all of the transmission information (columns 6-7); and
- Transmitting the E-mail information for respective receivers, with all of the transmission information sent to all respective receivers (i.e. receiver sensitive formatting; Figure 6- Emails for John, Harry, Mary and Original Email), (column 5; columns 8-9).

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In reference to claim 5, Gilbert discloses developed software program including instructions to carry out the recipient specific email methods on computing systems (column 4, lines 16-67). As applied to previous claims, functions of the electronic mail system, as shown by Gilbert, include: receiving transmission information from a sender to a plurality of receivers; emphasizing and highlighting the different parts of transmission information for each receiver; preparing E-mail information for respective receivers; and transmitting the E-mail information for respective receivers. Therefore, Gilbert teaches a system comprising executable code that specifically implements the previously stated functions. This is equivalent to the software program disclosed by the applicant.

In reference to claim 6, Gilbert shows a method (Figures 2&4; columns 4-7) comprising:

- Preparing transmission information to be transmitted from a sender to a plurality of receivers (Figure 2-item 60); and
- Emphasizing and highlighting the transmission information for respective receivers (Figure 2-items 64-68);
- Preparing E-mail information for respective receivers, (Figure 2-item 72);
- Transmitting the E-mail information including all of the transmission information to all respective receivers, (Figure 2-item 73);
- Emphasizing and displaying the transmission information for respective receivers, (Figure 2-item 76; Figure 4a; Figure 6; column 8).

In reference to claim 7, Gilbert explicitly discloses an E-mail system (Figure 1), comprising:

- Receiving means (Figure 1-receiver) for receiving transmission information transmitted from a sender (Figure 1-sender) to a plurality of receivers, transmitting means for transmitting the E-mail information for each receiver (column 3, line 24 to column 4, line 30); and
- Emphasizing means (i.e. network computer of sender) for emphasizing and highlighting (i.e. size, color, bold, italic, etc.; column 4, lines 54-67) the transmission information for respective receivers (i.e. select users to receive modified email message; column 5, lines 5-26), and preparing the email (i.e. embedding text format commands) for respective receiver (columns 5-7),
- Transmitting the E-mail information including all of the transmission information to all respective receivers (i.e. receiver sensitive formatting; Figure 6- Emails for John, Harry, Mary and Original Email), (column 5; columns 8-9).

In reference to claim 8, Gilbert discloses the E-mail system with recipient-specific content system includes:

- A system (Figure 1) for propagating a signal from a propagating computer (i.e. Figure 1-sender) to receiver computers (i.e. Figure 1-

receiver), (i.e. via network; Figure 1-item 10) the propagating computer of the system comprising a program (i.e. software program; column 4, lines 30-67),

As applied to previous claims, functions of the electronic mail system, as shown by Gilbert, include: receiving transmission information from a sender to a plurality of receivers; emphasizing and highlighting the different parts of transmission information for each receiver; preparing E-mail information for respective receivers; and transmitting the E-mail information including all of the transmission information to respective receivers.

In reference to claim 9, Gilbert explicitly discloses a method (Figures 2&4; columns 4-7) for recipient-specific content emailing. Gilbert discloses the method to comprise:

- Receiving information for different destinations with the information having different parts (Figure 2-items 60-64);
- Emphasizing the different parts responsive to the destinations (Figure 2-item 68-72; Figure 3);
- Sending all of the information by email to all the destinations with each destination receiving all of the information, to with at least one of the parts emphasized responsive to the destination (Figure 2-item 73); and

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- Displaying the information with one of the parts emphasized at at least one of the destinations, (Figure 2-item 76; Figure 4a; Figure 6; column 8).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert as applied to the claims above, and further in view of Krause et al (US Patent 6,154,757).

Gilbert shows substantial features of the claimed invention, as previously addressed. However, Gilbert does not teach a storing device storing keyword information predetermined for each receiver and subsequently highlighting these keywords included in E-mails. Nonetheless this feature would have been an obvious modification to the system disclosed by Gilbert as evidenced by Krause.

In an analogous art, Krause discloses an electronic text reading environment enhancement method and apparatus in which designated words and phrases can be emphasized in an electronic text (column 3, lines 59-63). Specifically, Krause shows a wordlist comprised of various words and phrases

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for the user (column 7, lines 19-38 and Figure 3). The contents of the wordlist are highlighted within displayed electronic text (column 29, lines 48-52 and Figure 14).

Given this feature a person of ordinary skill in the art at the time of the invention would have readily recognized the advantages of modifying the recipient-specific E-mail system disclosed by Gilbert in order for the recipient to maximize their speed and comprehension in reading electronic mail content (Krause column 3, lines 24-26).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaShanya R Nash whose telephone number is (571) 272-3957. The examiner can normally be reached on 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LaShanya Nash
Art Unit, 2153
December 12, 2005



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